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EXAMINER

COLBERT, ELLA

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/664,226

Filing Date: September 18, 2000

Appellant(s): LI ET AL.

Robert S. Blasi, Esq.
For Appellant

SUPPLEMENTAL EXAMINER'S ANSWER

This is in response to the amended appeal brief filed April 04, 2009 appealing from the Office action mailed September 12, 2005 and to the IDSs filed 1/10/06, 10/17/08 and 02/29/08.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,260,024	Shkedy	07-2001
6,647,373	Carlton-Foss	11-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 recites the limitation "subset of suppliers", "selected suppliers", and "selected subset of suppliers" in lines 12-17. Claim 27 has a similar problem. There is insufficient antecedent basis for this limitation in the claim.

Throughout the claims "selected suppliers" and "selected supplier" are referenced. There appears to be a lack of agreement in the claim limitations.

Claim Objections

Claims 1 and 27 are objected to because of the following informalities: Claim 1, line 5 recites "..., a objective function". This would be better recited "..., an objective function". Claim 27 has a similar problem. Appropriate correction is required.

Drawings

The drawings were received on 04/01/05. These drawings are acceptable.

New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because in fig.'s 6, 8-14, 15A, 15B, 16A, 16B, 17, 19, 20A, 20B, and 21-28 the shaded portion of the drawing figure's are not legible. The shading needs to be removed in order to read the text in the drawing figures. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent

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and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-15 and 27-41 are rejected under 35 U.S.C. 102(b) as being anticipated by (US 6,260,024) Shkedy.

As per Claims 1 and 27, Shkedy teaches, A computer-implemented method for determining an optimal award schedule for at least partial satisfaction of a requisition, said method comprising: receiving from a buyer, over a computer network, public buyer constraints representative of said requisition (col. 1, lines 66-col. 2, line 9); receiving from the buyer, over said computer network, an objective function including non-price criteria (col. 2, lines 10-34); transmitting to a set of prospective suppliers, over said computer network, said buyer constraints (col. 5, lines 7-30); receiving from each supplier, over said computer network, a bid responsive to public buyer constraints (col. 5, lines 43-60); and utilizing, by a programmed computer, the objective function to select a subset of suppliers and determine an optimal award schedule for at least partial satisfaction of said requisition utilizing the selected of suppliers (col. 7, lines 27-42, col.

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8, lines 60-67, and col. 9, lines 12-34), wherein said optimal award schedule includes information indicative of the manner in which each of said selected subset of suppliers is to at least partially satisfy said requisition (col. 13, line 7-col. 14, line 25).

As per Claims 2 and 28, Shkedy teaches, The method of claim 1, wherein receiving said public buyer constraints from said buyer over said computer network comprises receiving a list of items to be supplied (col. 13, lines 7-29).

As per Claims 3 and 29, Shkedy teaches, The method of claim 2, wherein receiving said list of items comprises receiving a list in which at least one item in said list is a logical item that includes a list of items (col. 13, lines 7-29).

As per Claims 4 and 30, Shkedy teaches, The method of claim 1, wherein receiving said public buyer constraints comprises receiving a constraint selected from the group consisting of a maximum price said buyer is willing to pay for at least partial satisfaction of said requisition; and a non-price constraint required by said buyer for at least partial satisfaction of said requisition (col. 7, lines 20-42 and col. 13, lines 53-59).

As per Claims 5 and 31, Shkedy teaches, The method of claim 4, wherein said non-price constraint is selected from the group consisting of a desired time for at least partial satisfaction of said requisition; a desired quality for at least partial satisfaction of said requisition; and a desired quantity for at least partial satisfaction of said requisition (col. 13, lines 36-61).

As per Claims 6 and 32, Shkedy teaches, The method of claim 1, wherein receiving said bid from each supplier over said computer network comprises receiving a

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bid including a proposed price for at least partial satisfaction of said requisition (col. 3, lines 39-57).

As per Claims 7 and 33, Shkedy teaches, The method of claim 1, wherein receiving said bid from each supplier over said computer network comprises receiving a bid including a proposed price having a volume discount dependent on an extent to which said requisition is to be at least partially satisfied (col. 6, lines 18-28).

As per Claims 8 and 34, Shkedy teaches, The method of claim 1, wherein receiving said bid comprises receiving a bid from each supplier over said computer network including a fixed charge independent of an extent to which said requisition is to be at least partially satisfied (col. 10, lines 14-25).

As per Claims 9 and 35, Shkedy teaches, The method of claim 1, wherein receiving said bid from each supplier over said computer network comprises receiving a bundled bid offering to at least partially satisfy, for a bundled price, a requisition for a selection of items from said list of items (col. 15, lines 42-57).

As per Claims 10 and 36, Shkedy teaches, The method of claim 1, further comprising facilitating an exchange of messages between a buyer and a supplier over said computer network (col. 16, lines 7-28).

As per Claims 11 and 37, Shkedy teaches, The method of claim 10, further comprising facilitating the multi-casting of a message sent by said buyer to all suppliers (col. 16, lines 39-61).

As per Claims 12 and 38, Shkedy teaches, The method of claim 1, wherein determining an optimal award schedule comprises considering a performance attribute for a supplier (col. 16, line 62-col. 17, line 22).

As per Claims 13 and 39, Shkedy teaches, The method of claim 12, wherein considering a performance attribute comprises selecting an attribute from the group consisting of the supplier's reputation for prompt delivery, the supplier's reputation for quality, geographical location of the supplier, the supplier's reputation for support and maintenance, and a user-defined attribute (col. 20, lines 29-49).

As per Claims 14 and 40, Shkedy teaches, The method of claim 12, wherein considering a performance attribute comprises considering a weight supplied by said buyer, said weight being indicative of an extent to which said performance attribute is to be considered in determining said optimal award schedule (col. 25, lines 31-48).

As per Claims 15 and 41, Shkedy teaches, The method of claim 14, wherein considering a performance attribute comprises determining a price penalty on the basis of said weight and incorporating said price penalty in a bid received from said candidate supplier (col. 26, line 46-col. 27, line 8).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

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Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 16-26 and 42-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US6, 260,024) Shkedy in view of (US 6,647,373) Carlton-Foss.

As per Claims 16 and 42, Shkedy failed to teach, wherein determining an optimal award schedule comprises applying a requirement that was not known to the suppliers. Carlton-Foss teaches, wherein determining an optimal award schedule comprises applying a private buyer constraint that was not known to the suppliers (col. 12, lines 8-42). It would have been obvious to one having ordinary skill in the art at the time the

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invention was made to determine an optimal award schedule comprises applying a private buyer constraint that was not known to the suppliers and to modify in Shkedy because such a modification would allow Shkedy to identify the evaluation dimensions along with how heavily it should be weighted in selecting a winning bid.

As per Claims 17 and 43, Shkedy failed to teach, wherein applying the unknown private buyer constraint comprises applying a business rule. Carlton-Foss teaches, wherein applying the unknown requirement comprises applying a business rule (col. 12, line 43-68 and col. 13, lines 1-4). It would have been obvious to one having ordinary skill in the art at the time the invention was made to apply the unknown private buyer constraint comprises applying a business rule and to modify in Shkedy because such a modification would allow Shkedy to have a bid ranking that merges the ratings into a single rating taking into consideration the number of quantitative dimensions.

As per Claims 18 and 44, Shkedy failed to teach, wherein applying a business rule comprises selecting a business rule from the group consisting of a business rule placing a limit on the number of selected suppliers, a business rule specifying properties of said selected suppliers, a business rule placing a limit on the number of items provided by a selected suppliers, a business rule placing a limit on the number of items provided by a cluster of selected suppliers, and a business rule placing a limit on an extent to which a selected supplier at least partially satisfies said requisition. Carlton-Foss teaches, wherein applying a business rule comprises selecting a business rule from the group consisting of a business rule placing a limit on the number of selected suppliers, a business rule specifying properties of said selected suppliers, a business

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rule placing a limit on the number of items provided by a selected suppliers, a business rule placing a limit on the number of items provided by a cluster of selected suppliers, and a business rule placing a limit on an extent to which a selected supplier at least partially satisfies said requisition (col. 9, lines 11-43). It would have been obvious to one having ordinary skill in the art at the time the invention was made to apply a business rule comprising selecting a business rule from the group consisting of a business rule placing a limit on the number of selected suppliers, a business rule specifying properties of said selected suppliers, a business rule placing a limit on the number of items provided by a selected suppliers, a business rule placing a limit on the number of items provided by a cluster of selected suppliers, and a business rule placing a limit on an extent to which a selected supplier at least partially satisfies said requisition and to modify in Shkedy because such a modification would allow Shkedy to terminate the bid if one or more of the conditions are not met.

As per Claims 19 and 45, Shkedy failed to teach, wherein placing a limit comprises selecting a limit from the group consisting of an upper bound and a lower bound. Carlton-Foss teaches, wherein placing a limit comprises selecting a limit from the group consisting of an upper bound and a lower bound (col. 11, lines 10-34).

As per Claims 20 and 46, Shkedy failed to teach, wherein the extent to which a selected supplier satisfies said requisition is measured by a monetary value of said extent. Carlton-Foss teaches, wherein the extent to which a selected supplier satisfies said requisition is measured by a monetary value of said extent (col. 11, lines 35-54).

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As per Claims 21 and 47, Shkedy failed to teach, wherein applying unknown requirement comprises rejecting any bundled bid. Carlton-Foss teaches, wherein applying unknown requirement comprises rejecting any bundled bid (col. 12, lines 43-60).

As per Claims 22 and 48, Shkedy and Carlton-Foss failed to teach, wherein applying the unknown requirement comprises manually selecting a supplier for inclusion in said list of selected suppliers, but it would have been obvious to one having ordinary skill in the art at the time the invention was made to apply the unknown requirement comprising manually selecting a supplier for inclusion in the list of selected suppliers because such a modification in Carlton-Foss would allow Carlton-Foss to have a list of suppliers that are handpicked for specific products. The manual selection of a supplier for inclusion in a listing of suppliers is well known to be performed by the buyer or purchasing person.

As per Claims 23 and 49, Shkedy and Carlton-Foss failed to teach, wherein applying the unknown requirement further comprises manually specifying an extent to which said manually selected supplier is to at least partially satisfy said requisition, but it would have been obvious to have the manually specifying an extent to which a supplier is at least partially satisfy with the requisition because such a process can be performed either manually or electronically. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the process of specifying an extent to which the selected supplier is to at least partially satisfy the requisition to be performed manually and to modify in Carlton-Foss because such a modification would

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allow Carlton-Foss to have the ability to place the name of the supplier on paper using a pencil and applying a buyer constraint for the requisition (bid).

As per Claims 24 and 50, Shkedy failed to teach, comprising generating by computer a code indicative of at least one reason for rejecting a losing bid. Carlton-Foss teaches, comprising generating by computer a code indicative of at least one reason for rejecting a losing bid (col. 6, lines 4-26). It would have been obvious to one having ordinary skill in the art at the time the invention was made to generate by computer a code indicative of at least one reason for rejecting a losing bid and to modify in Shkedy because such a modification would allow Shkedy to reject a losing bid if the bid is not submitted by the required date and time.

As per Claims 25 and 51, Shkedy failed to teach, wherein generating said code comprises incorporating into said code information indicative of whether said losing bid was rejected on the basis of a reason selected from a group consisting of an excessive price and an inadequate performance attribute. Carlton-Foss teaches, wherein generating said code comprises incorporating into said code information indicative of whether said losing bid was rejected on the basis of a reason selected from a group consisting of an excessive price and an inadequate performance attribute (col. 6, line 51- col. 7, line 17 and lines 23-31, and col. 8, lines 43-65). It would have been obvious to one having ordinary skill in the art at the time the invention was made to generate said code comprises incorporating into said code information indicative of whether said losing bid was rejected on the basis of a reason selected from a group consisting of an excessive price and an inadequate performance attribute and to modify in Shkedy

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because such a modification would allow Shkedy to reject the bid if the price for the good or service is excessive.

As per Claims 26 and 52, Shkedy failed to teach, further comprising selecting said requisition from the group consisting of a purchase of an item, a purchase of a group of items, a performance of a service, and a performance of a group of services. Carlton-Foss teaches, further comprising selecting said requisition from the group consisting of a purchase of an item, a purchase of a group of items, a performance of a service, and a performance of a group of services (col. 11, line 64- col. 12, line 7 and lines 18-21). It would have been obvious to one having ordinary skill in the art at the time the invention was made to selecting said requisition from the group consisting of a purchase of an item, a purchase of a group of items, a performance of a service, and a performance of a group of services and to modify in Shkedy because such a modification would allow Shkedy to have a price, service, warranty, configuration, installation, availability, delivery, and other characteristics for the item or items.

(10) Response to Arguments

Appellants' begin argument at page 4 of the Brief asserting that the claims satisfy the requirements of 35 U.S.C. 112 in claims 1 and 27. Claims 1 and 27 both recite a "set of suppliers," from which a "subset of suppliers" is subsequently selected and any "set" will inherently include a number of "subsets," and accordingly this rejection is clear error. The claims were also said to lack agreement for use of both "selected suppliers" and "selected supplier." When one supplier is claimed, the claims use the singular form;

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when more than one supplier is claimed, the claims use the plural form. This rejection is also clear error.

Response: (1) The Appellants' are misinterpreting the Examiner's rejection. Furthermore, any selected "set" will not inherently include a number of "subsets," and accordingly the rejection is not in clear error. A "set" of anything is "two or more" things. For example, a set of dishes includes usually eight dinner plates, eight cups, eight saucers, eight dessert plates, eight soup bowls, and eight salad plates or a collection of books or periodicals which form a unit. This is not a subset of dishes. A "subset" is defined as "a set each of whose elements is an element of an inclusive set". The noun "sub" is defined as "substitute". (2) The Appellants' do not have "selected suppliers" or "selected supplier" in any of the other claim limitations of claim 1 or claim 27. There should be "the selected suppliers" and "the selected supplier" in another claim limitation of the claim limitations in claims 1 and 27.

Appellants' argue on page 6 we respectfully submit that Shkedy neither teaches nor suggests the use of non-price criteria in an objective function, or the determination of an optimal award schedule.

Response: It is interpreted that Shkedy discloses an objective function and non-price criteria in col. 2, lines 10-34 and an optimal award schedule in col. 1, line 66-col. 2, line 8 and col. 7, lines 27-42, col. 8, lines 60-67, and col. 9, lines 12-34. An objective function is not clearly defined in the specification for a person having ordinary skill in the art to know what Appellants' mean by an objective function. Therefore, this claim limitation has been rejected giving the broadest reasonable interpretation.

USPTO personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997).

See also *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (“During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow.... The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.... An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.”).

Appellants’ then argue on page 7 the Shkedy system cannot create an “optimal award schedule” that allows multiple sellers to satisfy a buyer’s requisition in an optimal fashion because a single buyer always wins the entire award and there is no notion, in Shkedy, of selecting a subset of suppliers and determining an optimal award schedule for at least partial satisfaction of a requisition utilizing the selected suppliers.

Response: It is interpreted that the selecting suppliers and an optimal award schedule for partial satisfaction of a requisition utilizing the suppliers is in col. 7, lines 27-67. Shkedy discusses sellers (plurality of suppliers) in col. 7, lines 53-55 and partial satisfaction of a requisition utilizing the suppliers in col. 7, lines 32-41.

Appellants' on page 7 argue "Shakedy does not appear to teach a prospective seller may provide bids that do not conform to the non-price criteria, or how to weigh a prospective seller's non-conforming non-price criteria against a bidder price.

Response: Appellants' allegation that the applied reference fails to teach the claimed limitation of a prospective seller may provide bids that do not conform to the non-price criteria, or how to weigh a prospective seller's non-conforming non-price criteria against a bidder price and in other words, Shkedy cannot satisfy the requirements of the present claims that require an "objective function" including "non-price criteria" to create an optimal award schedule that is optimal with respect to both price and non-price criteria is respectfully submitted to be without merit. In particular, the Examiner respectfully submits that the Shkedy reference teaches the disputed feature. Note, for example, col. 2, lines 10-34 of the Shkedy reference. Appellants' allegations that the Shkedy reference fails to teach the aforementioned feature are merely conclusory and are not supported by any evidence provided by Appellants' which clearly and definitely call into question the cited passages of the applied reference. Appellants' have apparently failed to provide any reasonable analysis of the applied reference. Thus, it is respectfully submitted that Appellants' conclusions cannot take the place of evidence. In re Cole, 51 CCPA 919, 326 F.2d 769, 140 USPQ 230 (1964); In re Schulze, 52 CCPA 1422, 346 F.2d 600, 145 USPQ 716 (1965); Mertizner v. Mindick, 549 F.2d 775, 193 USPQ 17 (CCPA 1977).

Appellants' emphasize the prospective suppliers (also referenced as "candidate suppliers") choosing to submit bids in response to public buyer constraints and to send the bids across a computer network for analysis by a buyer, and optimal award

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schedule (a selected list of selected suppliers is from a set of candidate suppliers with information indicating which of the selected suppliers is to satisfy a requisition aspect of their invention while virtually ignoring other aspects in an attempt to impugn the rejections. The claim limitations do not contain "a selected list of selected suppliers is from a set of candidate suppliers". Appellants' are reading limitations from the specification into the claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Appellants' failed to mention or discuss the Carlton-Foss (secondary reference) other than to state that these *Claims 16-26 and 42-52* depend from independent claims 1 and 27 with the preceding discussion demonstrating that these base claims are patentable.

Also, the Examiner disagrees with the following sections of the Specification cited by the Appellants' as disclosing certain features of the claims:

Specification at pg. 10, ln. 8-13; pg. 26, ln. 1-pg. 28, ln. 10 as disclosing "the buyer provides an objective function including non-price criteria"; specification at pg. 3, ln. 19-21; pg. 25, ln. 27-pg. 26, ln. 3 is not interpreted as disclosing "The objective function is used to determine an optimal award schedule that includes a list of selected suppliers from the set of candidate suppliers and information indicative of the manner in which each of the selected suppliers is to satisfy (at least in part) the requisition"; and specification at pg. 8, ln. 7-14 is not interpreted as disclosing "a computer-readable

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media having encoded thereon software for determining an optimal award schedule for at least partial satisfaction of a requisition”.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Primary Examiner

/Ella Colbert/

Conferees:

Appeal Conference Specialist

Vincent Millin

Supervisory Patent Examiner

/Charles Kyle/ /crk/

Vincent Millin/vm/

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